

### **REMARKS**

This is intended as a full and complete response to the Office Action dated April 7, 2004, having a shortened statutory period for response with a one-month extension of time set to expire on August 7, 2004. Please reconsider the claims pending in the application for reasons discussed below.

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are made obvious under the provisions of 35 U.S.C. § 103. Thus, Applicant believes that all of these claims are now in allowable form.

### **I. OBJECTION TO THE DRAWINGS**

The Examiner has objected to the drawings. Specifically, the Examiner has required new corrected drawings "because Fig. 4 is an informal drawing." In response to the Examiner's objections to the drawings, Applicant has submitted herewith formal drawings to replace the informal drawings currently in the case. No new matter has been added.

### **II. REJECTION OF CLAIMS 1-10 UNDER 35 U.S.C. § 103**

#### **A. Claims 1-10**

In paragraph 3 of the Office Action, the Examiner has rejected claims 1-10 under 35 U.S.C. § 103. Specifically, the Examiner has rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over Liffick (U.S. Patent No. 6,421,439, issued July 16, 2002, hereinafter "Liffick") in view of Aravamudan et al. (U.S. Patent No. 6,301,609, issued October 9, 2001, hereinafter "Aravamudan") or alternatively Aravamudan in further view of Liffick. Applicant respectfully traverses this rejection.

Liffick discloses a communication system that combines telephone and Internet technology and provides user control of a contact list used for filtering incoming telephone calls. Specifically, Liffick discloses an affiliation list that could be segmented into a series of sub lists. (See Col. 7, line 57 through Col. 8, line 5.) (*emphasis added*.)

Aravamudan discloses a unified messaging solution and services platform that

utilizes instant messaging ("IM") services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action, and coordinate services among a plurality of communication devices, modes and channels. (See Col. 2, lines 25-49).

The Examiner's attention is directed to the fact that Liffick and Aravamudan (alone or in any permissible combination) fail to teach or suggest an instant messaging system that includes generating a recipient user controlled instant messaging contact list; segmenting the recipient user controlled instant messaging contact list; and selection by the recipient user of various ones of the segmented contact list and specifying a message category membership in each segmented contact list as a technique of specifying accessibility levels to messages of selected segments of the segmented contact list, as positively claimed by Applicant in independent claim 1, which recites (*emphasis added*):

1. In an instant messaging system, a method of controlling instant messaging access, by the steps of:
  - generating a recipient user controlled instant messaging contact list;
  - segmenting the recipient user controlled instant messaging contact list;
  - selection by the recipient user of various ones of the segmented contact list and specifying a message category membership in each segmented contact list as a technique of specifying accessibility levels to messages of selected segments of the segmented contact list.

Furthermore, Liffick and Aravamudan (alone or in any permissible combination) fail to teach or suggest the novel aspect of "[i]n an instant messaging system having a capability for sending instant messages. . . preparing a contact list of potential acceptable senders of instant messages; segmenting the contact list into a plurality of message categories and inserting selected names from the list of potential acceptable senders in selected ones of the plurality of message categories; enabling selected ones of the plurality of message categories for controlling the acceptance of instant messages from senders of the selected ones of the plurality of message categories[.]"

as positively claimed by Applicant in independent claim 6, which recites (*emphasis added*):

6. In an instant messaging system having a capability for sending instant messages and monitoring an on-line status of PCs connected to a managing server/servers, a method for permitting a recipient of instant messages to control accessibility to receive instant messages from a list of potential senders, comprising the steps of:

preparing a contact list of potential acceptable senders of instant messages;

segmenting the contact list into a plurality of categories and inserting selected names from the list of potential acceptable senders in selected ones of the plurality of categories;

enabling selected ones of the plurality of categories for controlling the acceptance of instant messages from senders of the selected ones of the plurality of categories.

An aspect of the present invention is directed to an instant messaging ("IM") system having more gradations of control of IM access by differentiating between desirable messages and undesirable messages. In other words, the instant messages being sent to the recipient user are checked against a user designated category, e.g., a message category membership within each segmented contact list. In turn, accessibility levels or the acceptance of the instant messages are based on the user designated categories. Thus, Applicant's claimed invention discloses a novel method of controlling the acceptance of instant messages, in part, through specifying a user designated category in each segmented contact list.

As described in the specification (page 3, lines 3-10):

Each sub list may contain a list of potential instant messengers interested in a particular focus (i.e., issue, subject matter, etc.). Some names of potential instant messengers may be common to more than one list. Each individual sub list is by recipient selection subject to certain conditions (i.e., set by a recipient) of acceptance or non-acceptance of instant messages addressed to the recipient. Conditions may encompass items such as availability of the recipient, busyness of the recipient, relations between sender and recipient, cause of the message such as an emergency, and other status factors to be set by the recipient.

Thus, the access criteria are not just based upon individual names, telephone numbers or aliases but on the user designated category associated with the identity of the sender. This allows a highly flexible method that permits a user to specify and/or modify levels of acceptance of incoming instant messages for a particular sender or a subset of senders within a much larger list of senders.

One advantage of this novel approach is to allow certain messages (e.g., an emergency message category) to pass through to the user recipient while preventing other messages (e.g., a non-emergency message category) from popping up on the user recipient's computer screen. (See page 5, lines 5-13.) Neither cited reference (alone or in permissible combination) teaches nor suggests these claimed features.

Liffick teaches a system and method for user affiliation in a telephone network for managing incoming calls. It is not related to the management of incoming instant messages. Thus, the user specified affiliation list in Liffick relates to telephone calls from one or more potential callers. The user can specify user-selectable call processing criteria for all incoming calls, incoming calls from selected callers, and apply conditional criteria based on user preferences. However, the disclosed user control is based upon the identification of the caller or the caller's telephone number or Internet subscriber identification.

Liffick is therefore not directed to the managing of instant messages by the user but rather to the controlling of telephone calls to the user. Because Liffick does not concern itself with instant messaging, there would be no need for and Liffick does not teach or suggest generating an instant messaging contact list. Likewise, there would be no need for and Liffick does not teach or suggest segmenting an instant messaging contact list. Finally, there would be no need to, and Liffick does not teach or suggest, specifying a message category membership in each of the segmented contact list. Therefore, Liffick fails as a primary reference since all the elements of Applicant's independent claims are missing in Liffick.

The significant gap left by Liffick as discussed above is not bridged by the combination of Aravamudan with Liffick. The Examiner has conceded that "Aravamudan did not specifically disclose segmenting the contact list and specifying an

accessibility level of the segmented list." (See Office Action, page 4, lines 2 to 3.) In other words, both references fail to disclose, at least, this limitation. As such, combining Liffick and Aravamudan would not make Applicant's invention obvious as claimed in independent claims 1 and 6.

Furthermore, claims 2-5 and 7-10 depend from independent claims 1 and 6, respectively, and recite additional limitations. For the same reasons discussed above, these dependent claims are allowable.

### **III. AMENDMENT TO CLAIM 1**

Applicant amended claim 1 for a typographical error. Thus, the amendment was not made in view of the cited references.


### **Conclusion**

Applicant submits that all pending claims now fully satisfy the requirements of 35 U.S.C. §103. Consequently, Applicant believes that all pending claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

8/9/04

  
\_\_\_\_\_  
Kin-Wah Tong, Attorney  
Reg. No. 39,400  
(732) 530-9404

Moser, Patterson & Sheridan, LLP  
595 Shrewsbury Avenue  
Shrewsbury, New Jersey 07702